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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/608,981
Filing Date: June 27, 2003
Appellant(s): KEANE ET AL.

Jessica Costa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/04/2008 appealing from the Office action mailed 08/20/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ryan (US 6,173,274).

Claim 1, Ryan teaches:

A computer-implemented product design method comprising providing one or more product design software tools, the tools being adapted to (a) allow a user to create an electronic product design (see col 12, lines 22-35) and (b) incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement (see col 9, lines 10-25)

Claim 2, Ryan teaches:

The method of claim 1 wherein the tools are further adapted to provide a product template to the user and allow the user to incorporate user content into the template to

create the electronic product design and wherein the advertisement is incorporated into the template (see col 9, lines 10-25; see figure 3)

Claim 3, Ryan teaches:

The method of claim 1 wherein the user must pay a fee to have the advertisement removed (see col 9, lines 10-25; col 10, lines 5-15)

Claim 5, Ryan teaches:

The method of claim 1 wherein the electronic product design is the design of a product that the user desires to be produced in physical form and wherein the method further comprises offering to produce the physical product for the user at a first price if the advertisement appears on the produced product (see col 9, lines 10-25; col 10, lines 5-15); and

offering to produce the physical product for the user at a second price if the advertisement does not appear on the produced product, the second price being greater than the first price (see col 9, lines 10-25; col 10, lines 5-15).

Claim 7, Ryan teaches:

The method of claim 5 wherein the electronic product design is the design of a product intended to be printed and the physical product is a quantity of printed copies of the printed product (see figure 1, item 17).

Claim 8, Ryan teaches:

A computer-implemented method for offering to produce products in physical form from an electronic product design prepared by a user, the method comprising offering to produce the physical product at a first price if advertising not provided by the

Art Unit: 3622

user is incorporated in the electronic product design such that the advertising will appear on the product when the product is produced (see col 9, lines 10-25; col 10, lines 5-15), and

offering to produce the physical product at a second price if advertising not provided by the user is not included in the electronic product design, the first price being lower than the second price (see col 9, lines 10-25; col 10, lines 5-15).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 6,173,274).

Claim 4, Ryan does not expressly teach:

The method of claim 1 wherein the tools are provided *by a business* to the user at no charge and wherein the advertisement is a promotional message for the business providing the tools. However, Official Notice is taken that it is old and well known in the promotion art that manufacturers pay to insert their ads in flyers or printed papers. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Ryan's postage meter manufacturers (*i.e.*

business) would be motivated to pay users for inserting said manufacturers' ads into said users' envelopes in order to give said users an incentive to participate in said manufacturers' system.

As per claim 6, Ryan does not expressly teach:

The method of claim 5 wherein the first price is free. However, Official Notice is taken that it is old and well known in the promotion art that advertisers offer consumers products or services for free when said consumers accept to view or display advertisements in said products. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers in the Ryan's system would subsidize certain printing jobs by offering certain printing for free, as it is old and well known to offer user free products when said users are willing to view or display advertisements in said products.

(10) Response to Argument

The Appellant argues in page 12 of the Brief that Ryan does not teach "providing one or more product design software tools, the tools being adapted to allow a user to create an electronic product design". The Appellant further argues that Ryan's data processing system 80 creates only a control code 82 and that there is no teaching, according to the Appellant, in Ryan that the data processing system 80 creates, either by itself or under the direction of the user an actual electronic product design. The Appellant further argues that since Ryan discloses no other software tool having a user interface, Ryan does not teach, according to the Appellant, creating an electronic product design. The Examiner answers that the Appellant is arguing about limitation not

stated in the claims when the Appellant argues that because Ryan does not teach an user interface, Ryan does not teach creating an electronic product design. Nowhere, in Appellant's claims is recited said "user interface" limitation. Appellant's claims simply recite "providing one or more software tools, the tools being adapted to allow a user to create a product design". Ryan teaches a data processing system under the control of a user that provides said user a tool to customize documents and create an electronic product design, such as high volume mailpieces (see col 5, lines 30-40) and where said data processing system allows said user to set parameters for controlling which advertisements would appear in each mailpieces of said high volume mailpieces (i.e. "electronic product design"; see Ryan col 5, lines 30-45; col 7, lines 25-45). Therefore, contrary to Appellant's argument, Ryan teaches the limitation "allow a user to create an electronic product design".

The Appellant argues in page 13 of the Brief that Ryan does not teach the limitation of "one or more product design software tools, the tools being adapted to incorporate into the design an advertisement not provided by the user". The Appellant further argues that in Ryan's system, it is the user, and not the data processing system 80 software tool itself or the third party advertisers, that selects the message to be printed, and therefore it is the user, according to the Appellant, that provides a message for incorporation into the items to be printed on the envelope. The Appellant further argues that the Ryan's system requires a user to actively select, and therefore provide, a message to be incorporated into the final printed envelope but according to the Appellant, his claimed invention incorporates an advertisement that was never

requested by, selected by, or provided by, not supplied by the user, into the user's design, and then requires the user to opt not incorporate it. The Examiner answers that the Appellant is arguing about limitation not stated in the claims. Nowhere, in Appellant's claims is recited anything that "not provided by the user" is the same as never requested by, or selected by, or, not supplied by the user, into the user's design, and then requires the user to opt not incorporate it. Appellant's claims simply recite "incorporating into the design an advertisement not provided by the user" and nothing else. Ryan teaches incorporating an advertisement into mailpieces created by a software tool, where said advertisements are not provided by the user, as said advertisements are provided by a third party and not by the user. Furthermore, Ryan's system provides the user the option to remove said advertisement from specific mailpieces (see col 9, lines 10-40). Therefore, contrary to Appellant's argument, Ryan teaches Appellant's claimed limitation of "incorporate into the design an advertisement not provided by the user".

The Appellant argues in page 14 of the Brief that Ryan does not teach "incorporate into the design an advertisement not provided by the user and offering the user the option of removing the advertisement". The Appellant further argues that in Ryan, the user must actively select a message to incorporate into the printed envelope but in the Appellant's claimed invention, according to the Appellant, the user action is the active selection not of which message to select, but rather of whether to opt in or out of a non-user-provided incorporated advertisement. The Examiner answers that the Appellant is arguing about limitation not stated in the claims. Nowhere, in Appellant's

claims is recited that user action is the active selection not of which message to select, but rather of whether to opt in or out of a non-user-provided incorporated advertisement. Appellant's claims simply recite "incorporate into the design an advertisement not provided by the user and offering the user the option of removing the advertisement". Ryan teaches a data processing system operated under the control of a user that produces high volume mailpieces (i.e. "electronic product design") where said system allow said user to incorporate into the product design (i.e. "producing high volume mailpieces") an advertisement provided by a third party and therefore, not by the user, and offering the user the option of removing said advertisement from said product design by giving the user the option to restrict the specific mailpieces said advertisement would be printed on (see col 9, lines 10-30). Therefore, contrary to Appellant's argument, Ryan teaches Appellant's claimed invention.

The Appellant argues in page 14 of the Brief that Ryan's teaching teaches away from the Appellant's claimed invention because according to the Appellant, Ryan's system requires a user to actively select a particular advertisement from a number of available subsidized advertisements, for printing on the envelope in order to take advantage of a subsidy associated with the selected ad, thus Ryan, according to the Appellant must provide incentive to get the user to opt to print the ad, the incentive in the form of a subsidy on the postage or meter invoice in exchange for printing the ad. However, according to the Appellant, users of the Appellant's claimed invention, must actively opt (for example by paying a surcharge) to remove a non-user advertisement from their user design, and thus, because there is additional work to remove the ad,

there is dis-incentive on the part of the user to remove the ad. The Examiner answers that the Appellant is arguing about limitation not stated in the claims. Appellant's claims simply recite "incorporating into the design an advertisement not provided by the user and offering the user the option of removing the advertisement" and nothing else. There is nothing in said limitation that there is a dis-incentive on the part of the user because said user is paying a surcharge to remove the ad. Ryan gives the user the option to remove advertisements from particular mailpieces in a product design (i.e. "high volume mailpieces" (see col 5, lines 30-35; col 9, lines 10-40). Therefore, contrary to Appellant's argument, the Appellant is arguing about limitation not stated in the claims and Ryan teaches Appellant's limitation of "incorporated into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement".

The Appellant further argues in page 15 of the Brief that Ryan discloses that user data profile may include an indicator which allows the user of the postage meter to bypass third-party advertisement altogether, however, according to the Appellant, if this indicator is set to bypass all advertisements altogether, the data processing system 80, does not search, or present or select any third party advertisement for possible incorporation into the printed envelope and therefore, according to the Appellant, would still not meet the limitation, "incorporate into the design an advertisement not provided by the user, and offering the user the option of removing the advertisement". The Examiner answers that contrary to Appellant's argument, Ryan teaches a data processing system 80 under the control of a user that produces high volume customized mailpieces (i.e. electronic product design) where set processing system allows said user

to automatically incorporate advertisements into all mailpieces in a product design but with the option of allowing said user to restrict the advertisements to be printed in specific mailpieces by allowing said user to remove advertisements from specific mailpieces (see col 9, lines 15-30). Therefore, contrary to Appellant's argument, Ryan teaches the limitation "incorporate into the design an advertisement not provided by the user (i.e. provided by a third party advertiser) and offering the user the option of removing the advertisement from specific mailpieces in the product design of producing high volume mailpieces.

The Appellant argues in page 16 of the Brief that Ryan does not teach "wherein the tools are further adapted to provide a product template to the user and allow the user to incorporate user content into the template to create the electronic product design and wherein the advertisement is incorporate into the template". The Appellant further argues that Ryan does not provide a design tool that provides a product template to a user, or any functionality for incorporating user-provided content into the template or any functionality for automatically incorporating an advertisement into the template. The Examiner answers that the Appellant is arguing about limitations not stated in the claims. Nowhere in Appellant claims is recited anything about "automatically incorporating an advertisement into the template". Appellant's claim 2 recites "allow the user to incorporate user content into the template to create the electronic product design and wherein the advertisement is incorporated into the template" and nothing else. Furthermore, Ryan's figure 3 can be construed as a "template" as it shows a product which has fixed and variable content (see col 7, lines 1-45) for the purpose of

expedite printing, where a user of the Ryan's system input the content that would be enter into the different spaces in the variable content of mailpieces, such as sender address and ad messages (see col 11, lines 27-50). Therefore, contrary to Appellant's argument, Ryan teaches Appellant's claim 2 limitation.

The Appellant further argues in page 16 of the Brief that Ryan's data processing system may present available messages to the user for selection if the selection is not automated by setting the "automated selection" flag in the preference data 804b of the user data profile 804, however, the Appellant argues, any message selected for printing either by the user's manual selection or user's request for automatic selection are not automatically incorporated into the printed design but are specifically requested by the user to be incorporated into the printed design. Thus, according the Appellant, Ryan does not meet the limitation "wherein the tools are further adapted to provide a product template to the user and allow the user to incorporate user content into the template to create the electronic product design and wherein advertisement is incorporated into the template". The Examiner answers that the Appellant is arguing about limitation not stated in the claim when the Appellant argues that in Ryan, user's manual selection or user's request for automatic selection are not automatically incorporated into the printed design but are specifically requested by the user to be incorporated into the printed design". Nowhere in Appellant claim 2 is recited that a user cannot request to incorporate content to be incorporated into the printed design or that allowing a user to incorporate user content into the template means automatically incorporated content into the printed design without specifically requested by the user to be incorporated into

the printed design. Appellant's claim 2 simply recites "provide a product template to the user and allow the user to incorporate user content into the template to create the electronic product design and wherein the advertisement is incorporated into the template". Ryan teaches allowing users to incorporate user content (i.e. recipient addresses and sender addresses) into a template (see figure 3 "fixed and variable data" (See col 7, lines 1-45) to create an electronic product design (i.e. produces high volume customized mailpieces"; see col 5, lines 30-40) and wherein advertisements are incorporated into the template (see figure 3). Therefore, contrary to Appellant's argument, Ryan teaches Appellant's claimed invention.

The Appellant argues in page 17 that Ryan does not teach the limitation "wherein the user must pay a fee to have the advertisement removed". The Appellant further argues that Ryan performs the opposite of this limitation namely, in Ryan, according to the Appellant, the user is paid to print advertisement. The Examiner answers that Ryan teaches allowing users to automatically includes advertisements in all mailpieces, where said users would be credited for said including except for the mailpieces that the Ryan's users indicate to not include advertisements. In said mailpieces that said user would not include advertisements and therefore, said user would have to pay a full price fee for mailing said mailpieces, as said user would not be credited for including an advertisement in said mailpieces (see col 9, lines 10-40). Therefore, contrary to Appellant's argument, Ryan teaches Appellant's claimed invention.

The Appellant argues in page 17 of the Brief that Ryan does not teach "an electronic product design prepared by a user" because according to the Appellant, to

the extent that there is an electronic design of an envelope, that design is created by the inserted printer not the user. The Appellant further argues that the user's action of reviewing a group of available advertisements and choosing one to be printed on an envelope otherwise designed entirely by the printer does not make the envelope fall within any definition of "an electronic product design prepared by a user". The Examiner answers that the Appellant is arguing about limitation not stated in the claims. Appellant's claim 8 recites "offering to produce products in a physical form from an electronic product design prepared by a user". Ryan teaches a data processing system 80 under the control of a user that produces high volume mailpieces from a design prepared by said user using said processing system where said user is allowed to select the content and advertisements to be printed in said mailpieces (see col 5, lines 30-40). Furthermore, in Ryan, the mailpieces are not entirely designed by the printer, as argued by the Appellant, because Ryan teaches that the user controls what messages and content would be printed in each mailpieces (see col 8, lines 55-67). Therefore, contrary to Appellant's argument, Ryan teaches the "electronic product design" limitation.

The Appellant further argues in page 17 of the Brief that Claim 8 requires that the advertising that is incorporating into the electronic product design is not provided by the user but in Ryan, according to the Appellant, the user provides the advertisement because an advertisement is incorporated only after it has been reviewed, selected and authorized by the Ryan's user. The Examiner answers that the Appellant is arguing about limitations not stated in the claim. Appellant's claim simply recites "an

advertisement not provided by the user is incorporated into the electronic product design" and nothing else. There is nothing in the claim that "an advertisement not provided by the user" means that the advertisement cannot be reviewed, selected and authorized by the user. In Ryan the advertisement incorporated into a product design is provided by a third party and therefore, said advertisement is not provided by the user. Therefore, contrary to Appellant's argument, Ryan teaches Appellant's claimed invention.

The Appellant argues in page 18 of the Brief that Ryan does not teach the limitation "wherein the tools are provided by a business to the user at no charge and wherein the advertisement is a promotional message for the business providing the tools" as recited in claim 4. The Appellant further argues that Ryan recites that the advertising is advertising for "third party advertisers" and there is no mention in Ryan of any advertisement being for the company that is providing the advertisement selection system. The Examiner answers that the Appellant is arguing that Ryan does not teach a limitation which the Examiner already indicated was missing in Ryan in rejecting claim 4. However, the Examiner did a obviousness rejection in rejecting claim 4 by taking an Official Notice, which the Appellant is not even challenging. Therefore, the Appellant is not making a proper challenge to the obviousness rejection done by the Examiner as the Appellant is not making any argument of why the Official Notice is incorrect or why the Examiner's obviousness rejection of claim 4 of "it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Ryan's postage meter manufacturers (*i.e.* business) would be motivated

Art Unit: 3622

to pay users for inserting said manufacturers' ads into said users' envelopes in order to give said users an incentive to participate in said manufacturers' system" is not obvious. Therefore, contrary to Appellant's argument, the Examiner's obviousness rejection of claim 4 is maintained.

Ryan teaches that it would have been obvious to teach Appellant's claim 4.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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April 20, 2008

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